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Hiroyuki Kishi

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EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HIROYUKI KISHI

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Application No. 09/986,026  
Technology Center 3600

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Mailed: March 4, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 18, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter requiring attention prior to docketing.

**EXAMINER'S ANSWER, GROUNDS OF REJECTION**

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed November 26, 2008 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds a new Ground of Rejection that has not been provided the required heading "New Grounds of Rejection" and/or which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth the following rejections:

- (1) Claims 1-4, 6, 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter [page 3]; and

- (2) Claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 [are] rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlin et al in view of Solomon et al. [page 4].

The last Office Action (Final Rejection mailed February 26, 2008), including any mailed Advisory Actions, lists the following rejection:

- (1) Claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 [are] rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlin et al in view of Solomon et al [page 2].

Correction of all Grounds of rejection for all claims is required.

### **CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed November 26, 2008;
- 2) to generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required;
- 3) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection)<sup>1</sup>; and
- 4) for such further action as may be appropriate.

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<sup>1</sup> In Technology Center 3600, only a Director may approve new grounds of rejection.

Application No. 09/986,026

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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